***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

In re PTA of U.S. Pat. No. 7,186,495 issued 03/06/2007:

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| Applicant: | Katsumi Maeda |
| Title: | (METH)ACRYLATE DERIVATIVE, POLYMER AND PHOTORESIST COMPOSITION HAVING LACTONE STRUCTURE, AND METHOD FOR FORMING PATTERN BY USING IT |
| Appl. No.: | 09/750,116 |
| Filing Date: | 12/29/2000 |
| Examiner: | R. Ashton |
| Art Unit: | 1752 |
| Confirmation No. | 6329 |

**RESPONSE TO JUNE 2010 DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

MS Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 1.322(a)(4), Patentee responds to the Decision mailed June 3, 2010 and respectfully submits that the Decision is in error. As explained in detail below, the Decision has two principal errors: it deducts too much time due to a purported applicant delay, and it improperly treats a notice of suspension as a section 132 action. Patentee respectfully requests the PTO to correct those errors and change the determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b).

Since the one-month date from the Decision was a Saturday, and the following Monday July 5th was a federal holiday, this response is being timely filed.

I. **The Decision Overcharges Applicant Delay**

Page 4 of the Decision deducts 267 days due to a purported applicant delay. In contrast, Patentee's May 2007 request for reconsideration acknowledged only 63 days of applicant delay, a difference of **204** days. The Decision does not explain how it arrived at its number, but Patentee believes it is due to the PTO forgetting that PAIR formerly mis-recorded the date of a response to an office action.

A non-final office action was mailed November 29, 2001. A response to that office action was filed on February 27, 2002 – within the three-month window for response. Nevertheless, the PAIR system formerly indicated that the response was not received in the PTO until September 20, 2002 – almost ten months after the November office action! Consequently, as of 2006 the PTO charged Patentee with **204** days of applicant delay.

In September 2006, Patentee submitted a request for reconsideration of PTA, pointing out the PTO error in entering the date of response. In its January 2007 "Decision Regarding PTA", the PTO wrote: "The Office agrees that the reduction of 204 days is in error. The Office finds that it did err in entering the date of response to the November 29, 2001 non-final rejection as September 20, 2002. The correct date is February 27, 2002 as asserted by applicants."

Just as the former reduction of **204** days was "in error," so too the present Decision's reduction of **204** days is likewise in error. The reduction is contrary to law, lacks any asserted basis in the record, and lacks any articulated rationale. Patentee requests that the PTO restore to the Patentee **204** days improperly charged as applicant delay.

II. **The PTO's Notice of Suspension is not an "action" under section 132**

Following a reply filed on March 31, 2003, the Examiner suspended prosecution (Rule 103(e)) in a letter dated June 20, 2003.

Page 4 of the Decision states that "the Office did respond to the reply [of March 31, 2003] within 4 months after the date on which the reply was filed." Page 3 of the Decision states: "The letter of suspension mailed on June 20, 2003 is considered an action under 35 U.S.C. 132."

The PTO's position is incorrect and fails to comply with its own rules on point.

The PTO interpreted 35 U.S.C. § 154(b)(1)(A)(ii) via rulemaking. 65 Fed. Reg. 56,366 (Sep. 18, 2000).

In particular, 37 C.F.R. § 1.703(a)(2) reads (emphasis added):

> "The period of adjustment under §1.702(a) is the sum of the following periods . . . (2) The number of days, if any in the period beginning on the day after the date that is four months after the date a reply under §1.111 was filed and ending on the date of mailing of either an **action under 35 U.S.C. 132**, or a notice of allowance under 35 U.S.C. 151, whichever occurs first....

35 U.S.C. § 132 (a) reads (emphasis added):

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such **rejection, or objection or requirement**, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, **the application shall be reexamined**....

The suspension letter dated June 20, 2003 is neither a Notice of Allowance nor an action under 35 U.S.C. § 132, as that term is used in 37 C.F.R. § 1.703(a)(2).

The PTO cites no interpretive authority for its position that a suspension letter is "considered an action under 35 U.S.C. 132." The Decision cites no case law of any federal court, no pronouncement by the Commissioner, no Board-level case law, no notice-and-comment rulemaking. Moreover, the Decision lacks any reasoned explanation of which § 132-category the suspension letter supposedly falls into; and the Decision also lacks any explanation of how such an interpretation squares with the rest of the section and with the broader statutory scheme. A suspension letter is not a "rejection," an "objection," nor a "requirement" as used in § 132(a).

The suspension letter of June 20, 2003 indicated that the claims were allowable and never set a time for prosecuting the application under 35 U.S.C. § 133. Thus, the delay is 100% attributable to the PTO, because there was nothing that Patentee could have done to persist in getting the application "reexamined."

A suspension of action cannot logically amount to an action under § 132 merely because the Office initiated the suspension. A suspension of action is a delay, and a PTO suspension letter is the PTO's admission of delay. No provision allows the PTO to excuse its delay by notifying applicant that the PTO will delay.

Furthermore, if an applicant is charged with delay for initiating a suspension, 37 C.F.R. § 1.703(c)(1), then there is no reason to excuse the PTO for its delay. Along these lines, the MPEP even recognizes that suspensions at the PTO's initiative, e.g., under Rule 103(e), may lead (and here should lead) to patent term adjustment. MPEP § 709II.

Moreover, following a suspension by the PTO, the rules require nothing of the applicant. In contrast, the MPEP recognizes two "requirements" under § 132, namely, a restriction requirement and a requirement for information under Rule 105. MPEP § 709IC(1)(E). For these requirements, action by the applicant is required before the PTO continues prosecution.

In the present '116 application file history, no action was required of the applicant (now Patentee) in response to the letter of suspension dated June 20, 2003.

The suspension letter dated June 20, 2003 is not an action under 35 U.S.C. § 132. Therefore, the Office's initial calculation of 1075 positive days, which is the number of days beginning four months after the Applicant's reply was filed on March 31,2003, until a Notice of Allowance was issued on July 10, 2006, was correct since this calculation was in accordance with the PTO's regulations. A PTO reduction of that initial calculation of 1075 positive days is inconsistent with 5 U.S.C. § 706, it is arbitrary and capricious, and it is contrary to the restorative purposes underlying chapter 14 of Title 35 U.S.C., and subpart F of 37 C.F.R.

III. **Conclusion**

A. Correct Patent Term Adjustment: in view of the foregoing, Patentee respectfully requests the PTO to correctly award **1,411 days** of PTA.

No fee is believed due. The Commissioner is hereby authorized to charge any fees which may be required for this Response, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment

form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date 6 July 2010

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